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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,972	08/09/2001	Giancarlo Bisazza	07881.0011	3149

7590 08/10/2004
Finnegan, Henderson, Farabow
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Washington, DC 20005-3315

EXAMINER

HAWKINS, CHERYL N

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/924,972

Applicant(s)

BISAZZA ET AL.

Examiner

Cheryl N Hawkins

Art Unit

1734

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☒ The proposed amendment(s) will not be entered because:
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-4,6-14,24 and 25.Claim(s) withdrawn from consideration: 15-23,26 and 27.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
 10. ☐ Other: _____


 CURTIS MAYES
 PRIMARY EXAMINER

Continuation of 2. NOTE: As to the proposed claim limitation of the suction drum rotating means being configured to be lowered and lifted, such that after releasing one of the sheet segments, the suction drum is raised to allow the advancing frame to pass and then lowered back when a next incoming frame is in a suitable position to receive another one sheet segment, the suitable position corresponding to a location a few millimeters from the perimeter of the advancing frame where an end of the sheet segment is placed, this claim limitation has not been previously considered and would require further search and/or consideration.

Continuation of 5. does NOT place the application in condition for allowance because:

In response to the applicant's arguments that the applied references fail to disclose the claimed combination including a device for producing panels of mosaic tesserae having at least a supporting and/or lining sheet on a visible face of the tesserae arranged inside an advancing frame, application means for applying the sheet over the mosaic tesserae, and suction drum rotating means to retain at least temporarily, on an outer cylindrical surface thereof, the sheet segments, and to release the segments onto the mosaic tesserae, the examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since the applicant has not provided any persuasive argument to suggest that the prior art structure disclosed by Hottendorf would be not capable of applying sheet segments to panels of mosaic tesserae, the Examiner maintains that the device disclosed by Hottendorf as modified is capable of performing the claimed intended use and thereby meets the claim limitations.

In response to the applicant's arguments that the device of Hottendorf would be incapable of use with a frame containing a plurality of mosaic tesserae as required by the present invention, the examiner disagrees and asserts that the device of Hottendorf would be capable of applying a sheet segment to a panel of mosaic tesserae being acted upon in a vertical or inverted position as long as the mosaic tesserae have already been permanently bonded to one another and the outer edges of unified mosaic tesserae are firmly retained by the frame.

In response to applicant's argument that the references of Hottendorf and Morel et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art reference of Hottendorf is in the field of the applicant's endeavor which is the feeding, cutting, and applying of sheet segments onto corresponding advancing articles. It is noted that the secondary reference of Morel et al. is relied upon only to provide evidence that clamping mechanisms are well known and conventional for blocking pressurized airflow.

In response to the applicant's arguments that the device of Hottendorf would be rendered unsatisfactory for its intended purpose if modified with Morel et al. as proposed by the examiner, the examiner disagrees. The examiner maintains that it would have been readily apparent to one of ordinary skill in the art that a baffle and a clamping mechanism are functionally equivalent and that when modifying the device of Hottendorf to include a conventional clamping mechanism, one of ordinary skill in the art would recognize how to replace the function of the baffle with an air flow clamping mechanism such that the pressurized air flow is terminated only in the area where the sheet segment is to be released as taught by Hottendorf.

In response to the applicant's arguments that one with ordinary skill in the mosaic tesserae art would not look to the box tape art for knowledge, the examiner acknowledges that one concerned with the mosaic tesserae art would not look specifically to the box tape art for knowledge. However, the examiner maintains that one looking to apply cut sheet segments to mosaic tesserae would indeed look to the art area containing devices which cut and apply sheet segments to other substrates, e.g. devices which cut and apply tape to boxes.

In response to the applicant's arguments that the applied references fail to disclose a means for delivering steam or nebulized water arranged in cooperation with the visible face of the mosaic tesserae, said means to deliver being configured to deliver a jet against the face to reactivate the gluing means on the sheet, the examiner again notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since the applicant has not provided any persuasive argument to suggest that the prior art structure of the references as combined would be not capable of applying steam or nebulized water to panels of mosaic tesserae, the Examiner maintains that the device disclosed by the references as combined is capable of performing the claimed intended use and thereby meets the claim limitations.

Cheryl N. Hawkins 8/5/04
Cheryl N. Hawkins
August 5, 2004